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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,306	02/05/2001	Martin L. Hess	3801P001C3	3917

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EXAMINER

VU, VIET DUY

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 01/14/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,306

Applicant(s)

HESS ET AL.

Examiner

Viet Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 19-28,32-49 and 53-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 19-28,32-49 and 53-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,8,9,10. 6) ☐ Other: _____

Non-Art rejections:

1. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1970); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

2. Claims 19-28, 32-49 and 53-58 are rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent No. 6,058,417.

Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 1-3 of

prior patent contain almost all limitations recited in present claims 19-28, 32-49 and 53-58. It is further noted that description information related to an auction item usually includes title, bidding price and ending time.

3. Claims 19-28, 32-49 and 53-58 are rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent No. 6,415,320.

Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 1-8 of prior patent contain all limitation recited in present claims 19-28, 32-49 and 53-58. It is further noted that description information related to an auction item usually includes title, bidding price and ending time.

4. Claims 19-28, 32-49 and 53-58 are provisionally rejected under the judicially created doctrine of double patenting as being unpatentable over prior U.S. Patent Application Serial No. 09/436,566.

Although the conflicting claims are not identical, they are not patentable distinct from each other because claims 1-5 and 21 of prior patent application contain all limitation recited in present claims 19-28, 32-49 and 53-58. It is further noted that

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description information related to an auction item usually includes title, bidding price and ending time.

Art Rejection:

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 19-28, 32-49 and 53-58 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kernz, U.S. pat. No. 6,366,899, in view of Odom et al, U.S. pat. No. 6,058,379.

Per claims 19-20 and 22, Kernz discloses an electronic auction system and method for facilitating person-to-person commerce comprising:

- a) storing at a listing site a plurality of thumbnail images including at least first and second thumbnail images associated with items for sale (see Kernz's col 9, lines 39-45), the thumbnail images being seller-specified images that are stored at the local site (Kernz's col 7, lines 45-49) or at a remote site (see Kernz's col 13, lines 35-48),
- b) combining the first and second thumbnail images onto a web page for presentation at a remote site in response to a user query (see Kernz's col 9, lines 36-43 and col 12, lines 1-55).

Kernz does not explicitly show the step of retrieving or transmitting seller-specified item descriptions and images from a remote site to the listing site. Odom discloses a prior art electronic auction system comprising a listing server for retrieving/downloading user-supplied data from a remote site (see Odom's col 9, lines 18-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Odom's image retrieving step in Kernz because it would have allowed Kernz to store and compile data and images on the listing server.

Per claim 21, Odom teaches providing users information related to item including title/identifier, start/stop time, bid history, etc., (see Odom's col 5, lines 11-57).

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Claims 32-40 and 46-47 are similar in scope than that of claims 19-22 and hence are rejected for the same rationale set forth for claims 19-22.

Per claims 23-28 and 48-49, Kernz does not teach specific steps of creating thumbnail images from the standard images. An official notice is taken that such thumbnail image generation method is well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize any conventional technique to generate thumbnail images from standard images because it would have enabled practicing Kernz's invention (see Kernz's col 9, lines 42-43).

Per claims 41-45, Odom teaches registering listing items from a seller (see Odom's col 5, lines 11-38). Odom does not explicitly teach registering the listing items via web pages. It would have been obvious to one of ordinary skill in the art to realize such web-based registration process because it would have enabled both buyer and seller to access listing web server using conventional web browser (see Odom's col 4, lines 61-65 and col 5, lines 46-48).

Per claims 53-58, Odom teaches associated the listing item including description information and images with a listing number or identifier (see Odom's col 5, lines 38-45).

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Conclusion:

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is (703) 305-9597. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



**VIET D. VU
PRIMARY EXAMINER**

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1/2/04